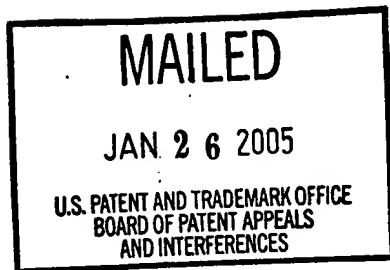


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LARRY J. DAY, MERLE S. WEINKAUF
and THEODORE KNUTSON



Appeal No. 2004-1718
Application No. 09/619,134

ON BRIEF

Before FRANKFORT, NASE, and NAPPI, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 102 to 197 and 200 to 211, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 198 and 199 were canceled subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to point of sale marketing and purchase behavior monitoring (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 102 to 197 and 200 to 211 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,321,208² to Barnett et al. (Barnett).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed February 5, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 22, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the Barnett patent, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the

² Issued November 20, 2001.

evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 102 to 197 and 200 to 211 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection of the independent claims on appeal (i.e., claims 102, 148, 194 to 197, 200 to 202, 206, 210 and 211), the examiner ascertained that Barnett discloses all of the claimed subject matter except that "Barnett does not explicitly disclose that the personal computer where the coupons are selected can be a kiosk" (answer, page 4). Next, the examiner stated that "Barnett does disclose that the coupon obtainment device can be wired or wireless (col 13, lines 35-45., col 6, lines 35-45) and thus flexible

as to its location. Barnett further discloses a kiosk where coupons can be selected and obtained (col 3, lines 35-45)." The examiner then concluded that "it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett's coupon selection and obtainment device or computer can be a kiosk. One would have been motivated to do this because a kiosk is a convenient way of obtaining coupons."

The United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

After reviewing both the appellants' view (brief, pages 12-16 and 19-22) and the examiner's view (answer, pages 16-20) as to the proper meaning of the term "kiosk," it is our view that the term "kiosk" as used in the claims in this application means a small freestanding structure, such as a booth or housing, that includes both a customer interface into which the customer can enter a customer identification to be sent to a

remote computer, such as a store level computer, and an offer communicator which communicates offers to customers accessing the customer interface.

Barnett's invention does not involve a kiosk as recited in independent claims 102, 148, 194, 195, 200 to 202 and 206. Instead, Barnett teaches to provide the customer interface (i.e., personal computer 6) and the offer communicator (i.e., printer 8) at a site remote from the store such as a users' home. In the background of the invention section of Barnett, he states (column 3, lines 35-44) that:

U.S. Pat. No. 5,176,224 to Spector teaches a closed-loop coupon system which consists of a kiosk type printer station located at a retail store. The kiosk is linked to the manufacturers in order to obtain specific coupon information. The consumer selects the desired coupon at the kiosk, and the coupon is printed and dispensed. The consumer presents the coupon at the register, where the discount is applied and the discount transaction data is transmitted back to the manufacturer.

Barnett then goes on to indicate (column 3, lines 52-61) that:

While these aforementioned prior art attempts at providing couponing systems are useful in their own right, they fail to provide for a secure and interactive coupon generation system in which the user can request, select, store, manipulate and print coupons as desired, in which user-specific information such as demographic data and data representative of those coupons so requested, selected, printed and actually used may be provided back to the coupon issuer and distributor for more efficient coupon targeting in subsequent coupon issuance and distribution.

Thus, Barnett teaches away from a kiosk.

It is our opinion that there is no evidence before us that would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have placed Barnett's customer interface (i.e., personal computer 6) and offer communicator (i.e., printer 8) in a kiosk. As to the examiner's stated motivation (i.e., "[o]ne would have been motivated to do this because a kiosk is a convenient way of obtaining coupons"), there is no evidence in the rejection before us to support this motivation.

For the reasons set forth above, the decision of the examiner to reject independent claims 102, 148, 194, 195, 200 to 202 and 206, and claims 103 to 147, 149 to 193, 203 to 205 and 207 to 209 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claim 210 includes the limitation "means for presenting customized special offers to customers." Claim 211 includes the limitation "means for presenting special offers to customers of a chain of stores."

35 U.S.C. § 112, paragraph 6, provides that:

An element of a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the

corresponding structure, material, or acts described in the specification and equivalents thereof.

Where a claim uses the word means to describe a limitation, we presume that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses. See Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997) (citation omitted). This presumption can be rebutted where the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety. Id. at 1427-28, 44 USPQ2d at 1109.

We conclude that the above-quoted means clauses from claims 210 and 211 are means-plus-function clauses. Once it has been concluded a claim limitation is a means-plus-function limitation, one must ascertain the corresponding structure in the written description that is necessary to perform that function. In our view, the structure that corresponds to both of these clauses is the kiosk 26 having the customer interface 28 and the offer communicator 32. Since there is no evidence in the rejection before us in this appeal that would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have placed Barnett's customer interface (i.e., personal computer 6) and offer communicator (i.e., printer 8) in a kiosk as set forth

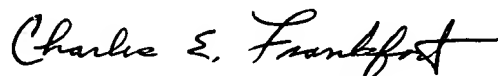
above, the decision of the examiner to reject independent claims 210 and 211 under 35 U.S.C. § 103 is also reversed.

Independent claims 196 and 197 include the limitation that incentive offer criteria is transmitted from a supervisory computer to a store level computer which is in communication with at least one database storing the incentive offer criteria and containing customer shopping habit data. In Barnett, the database 11 which stores the incentive offer criteria and customer shopping habit data is coupon distributor 16 which is not a store level computer. Thus, the subject matter of claims 196 and 197 is not taught or suggested by Barnett. Accordingly, the decision of the examiner to reject independent claims 196 and 197 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 102 to 197 and 200 to 211 under 35 U.S.C. § 103 is reversed.

REVERSED



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



ROBERT NAPPI
Administrative Patent Judge

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